

## REMARKS

In the present application, claims 1-39 are pending. Claims 1-3, 7-14, 16, 20, 22-26, 28-30, 33, 35, and 39 are rejected and claims 4-6, 15, 17-19, 21, 27, 31-32, 34, and 36-38 are objected to as being dependent upon a rejected base claim. In view of the following remarks, Applicant respectfully requests reconsideration of the application and allowance.

### Rejection Under 35 U.S.C. §103

In paragraph 2, the Examiner rejected claims 17, 20, 33, and 39 as being obvious over *Jespersen* (USPN 6,253,438) in view of *Coulthard* (USPN 5,207,011). Applicant traverses.

*Jespersen* generally discloses a mechanism for breaking connection ties on a rotatable label. These connection ties are only shown and described as being perforations. Thus, *Jespersen* is only concerned with labels that are temporarily coupled via a perforation line (i.e., a part of the label is permanently affixed to the object and the breaking of the perforation adjacent to this permanently affixed portion allows a non-affixed portion to rotate) and only concerned with breaking these couplings. A rotatable label not utilizing a perforation is not contemplated in the system of *Jespersen* and may not function correctly in the mechanism of *Jespersen*.

*Coulthard* provides a display system for interchangeable displays having a flat (wall) mounted display panel in which display strips (i.e., photo-negative strips) may be positioned so light may pass through them for viewing. The cited electrostatic charge portion of *Coulthard* refers to a static cling material which must be permanently adhered to the photo-negative strips. The removal of the electrostatic charge from *Coulthard* will cause the strips to fall off the display, thus rendering the viewing aspect of *Coulthard* inoperable.

Additionally, *Coulthard* only contemplates the use of photo-negative strips. These strips are not comparable to a label that is coupled about a container or object, nor would one skilled in the art contemplate substituting photo-negative strips and labels - **they do not have equivalent uses**. Therefore, it is inconceivable that one skilled in the art would be motivated to combine the teachings of *Jespersen* and *Coulthard*.

Further, there is no discussion or suggestion of applying the principles of *Coulthard* in a labeling environment. Nor would one skilled in the art be motivated to combine the teachings of a flat display panel device for manual use with an automated assembly line system for breaking connection ties on a rotatable label located about an object. As such, there is further support for the lack of motivation to combine the teachings of *Coulthard* with *Jespersen*.

In paragraph 3, the Examiner rejected claims 8, 13, and 22 as being unpatentable over *Jespersen* in view of *Brombacher* (USPN 5,324,559). The Examiner provides that "the releasable and readherable adhesive dots of Brombacher would allow a user to move the window in the outer label to a desired location and then press against the label to prevent it from moving while the underneath indicia is exposed.... Once that set of instructions is found, it would be helpful to maintain the window in a fixed position thereafter." *Office Action*, ¶11. "Brombacher teaches that a consumer can easily remove and replace an outer label using this adhesive." *Office Action*, ¶3. Applicant traverses.

The emphasis of *Brombacher* and the Examiner's motivation for combining *Brombacher* is that the adhesive dots are used to reseal the label. Embodiments of the present invention, however, are not concerned with resealing the rotatable label to the object. In fact, resealing defeats the purpose of removing the temporary coupling mechanism (i.e., the dot of adhesive) in the present application - to allow the outer label to rotate. Additionally, the dot of adhesive in the present application, once removed,

can not be used to reseal the label as it loses its adhesive quality. Therefore, there is no suggestion or motivation to use *Brombacher* for the purposes of the claimed invention.

Additionally, *Brombacher* cites that "there are no perforations to tear, or other obstructions to opening the booklet label." (col.3, l.60-62). This teaches away from *Jespersen* which is **only concerned with breaking a perforation** in order to allow the rotatable label to rotate.

In fact, the **functionality of the two cited references is completely opposite** – *Jespersen* is concerned only with breaking couplings (i.e., perforations) while *Brombacher* emphasizes resealing the couplings. The teachings of *Brombacher* cannot be applied to *Jespersen* since *Jespersen* is designed to only remove the coupling, which once removed cannot be resealed. Furthermore, there is **no desire to reseal the label in *Jespersen***; it defeats the purpose of the connection breaking mechanism of *Jespersen*. Therefore, there is no motivation or suggestion to combine the teachings of *Brombacher* with *Jespersen*.

In paragraph 4, the Examiner rejected claim 29 as being unpatentable over *Jespersen* in view of *Morgan* (USPN) 3,750,317 and *Brombacher*. As previously discussed, there is no motivation to combine the teachings of *Jespersen* and *Brombacher*. There is further no motivation to combine the teaching of *Morgan*, which is only concerned with a permanent label connection that is torn off and disposed of, with a resealable label and a mechanism to break perforations. Therefore, claim 29 is allowable.

#### Double Patenting

In paragraphs 5-9 of the Office Action, the Examiner rejected various claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-19 of U.S. Patent No. 6,086,697. Specifically, the Examiner rejected claims 1-3, 8-9, 11-14, 16, 22-24, and 35 over claims 15-19 of U.S. Patent No.

6,086,697 alone, claims 7, 20, and 39 over claims 15-19 of U.S. Patent No. 6,086,697 in view of *Coulthard*, claims 10, 25-26, 28-29, and 30 over claims 15-19 of U.S. Patent No. 6,086,697 in view of *Morgan*, and claim 33 over claims 15-19 of U.S. Patent No. 6,086,697 in view of *Morgan* and *Coulthard*.

In response, Applicant is concurrently submitting a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the double patenting rejection. The present application and the conflicting patent are commonly owned. As such, the double patenting rejection of claims 1-3, 7-14, 16, 20, 22-26, 28-30, 33, 35, and 39 are overcome.

#### Allowable Subject Matter

In paragraph 9, the Examiner objected to claims 4-6, 15, 17-19, 21, 27, 31-32, 34, and 36-38 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant would like to thank the Examiner for finding these claims allowable. With the submission of the terminal disclaimer, the base claims and intervening claims are now allowable. Therefore, claims 4-6, 15, 17-19, 21, 27, 31-32, 34, and 36-38 are allowable without amendment.



Conclusion

Based on the foregoing remarks, Applicant believes that the objections and rejections in the Office Action are fully overcome and that the application is in condition for allowance. If the Examiner has any questions regarding the case, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,

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Dated: December 20, 2005

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